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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,339	03/24/2004	J. Michael Joseph	051252-5246	3495
9629	7590	06/27/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			CRANE, DANIEL C	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/807,339	Applicant(s) JOSEPH ET AL.	
	Examiner Daniel C. Crane	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13 and 16-22 is/are rejected.
- 7) ☒ Claim(s) 4-12, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/04 & 3/24/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gray (1,801,153). See the Figures where the punching tool 11 is formed with an elongated body having an end that includes a pilot portion with a terminal end (unlabeled), a main portion 21 and a transition portion 20. The terminal end and main portion 21 are shown as be offset relative to the axis of the tool and the main portion is shown to have a greater surface area than the terminal end, as clearly shown in Figure 3. The transition portion 21 is also shown as being planar evident from Figures 2 and 3. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576,

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152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). As to claim 2, see Figure 5.

Claims 3, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (1,801,153). As to the dimensional relationship between the first and second surfaces, it is the examiner's position that the skilled artisan having the benefit of Gray's structure would have been disposed to structure the surfaces so that pilot 14 and cutting portion 13 cooperate with a specifically sized opening while facilitating cutting of the material about the opening. The material of the tool would have been dependent upon its use. Treated steel tools are known for their durability. While Gray does not indicate that the tool is provided with two stop members to prevent movement of the workpiece, it is the examiner's position that such would have been envisioned by Gray so as to securely position the workpiece on the die 12 thereby preventing any lateral movement of the workpiece. Furthermore, such is common in the punch art for the noted motivation. Accordingly, it would have been obvious to the skilled artisan to have modified Gray's tool by further providing stops as well known in the art for the noted motivation.

Claims 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Takeshita (6,678,955). See Figures 7-10 where the material being displaced (Figure 9A) to form a first orifice wall at an acute angle to the plane of the surfaces of the workpiece and during the formation, by the tool 41, approximately twenty five percent of the orifice area will be displaced at one point of the operation. Lateral movement of the workpiece will be prevented by the dies

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42, 43. As shown in Figure 9A, one wall of the cavity, defined by the terminal end of the tool 41, has an acute angle while the other wall of the cavity, defined by the tool end 45, is obtuse.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeshita (6,678,955). As discussed above, the walls of the cavity are acute and obtuse, as measured from one point. The specific angle would have been dependent upon the desired shape of the orifice and the nozzle spray needed. Accordingly, it would have been obvious to the skilled artisan at the time of the invention to have modified Takeshita's operation by situating the angles of the orifice for predetermined spray characteristics.

INDICATION OF ALLOWABLE SUBJECT MATTER

Claims 4-12, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

RESPONSE BY APPLICANT(S)

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the

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references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is (571) 272-4516. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Derris Banks, can be reached at (571) 272-4419.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number (703) 872-9306. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is (571) 273-4516.

DCCrane
June 22, 2005



Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725